

Appl. No. 09/881,360
Amdt. dated January 27, 2006
Reply to Office Action of November 1, 2005

PATENT

REMARKS/ARGUMENTS

Amendments

Before this Response, claims 1-3, 5-9, 11-18 and 20 were present for examination. No claims are amended or added. Therefore, claims 1-3, 5-9, 11-18 and 20 are present for examination, and claims 1, 7, and 13 are the independent claims.

The Office Action dated November 1, 2005 ("Office Action") rejected claims 1-3, 6-9, 11, 13-15, 17 and 18 under 35 U.S.C. §102(e) as being anticipated by the cited portions of U.S. Patent No. 6,760,602 to Tangorra et al. (hereinafter "Tangorra"). The Office Action rejected claims 5, 12 and 20 under 35 U.S.C. §103(a) as being unpatentable over Tangorra. The Office Action rejected claim 16 under 35 U.S.C. §103(a) as being unpatentable over Tangorra in view of the cited portions of U.S. Publication No. 2002/0018487 to Chen et al. ("Chen"). The Applicant respectfully traverses the rejection.

35 U.S.C. §102(e) Rejection, Tangorra

The Office Action rejected independent claims 1, 7, and 13 as being anticipated by Tangorra. For a valid anticipation rejection, the Office must show that each limitation from the claims appears in a single piece of prior art. The Applicant believes significant limitations from the independent claims 1, 7 and 13 are neither taught nor suggested in the Tangorra reference. Specifically, Tangorra cannot be relied upon to teach or suggest a determination of compatible communication modes from among a *plurality* of communication modes associated with the *terminating end*.

The claims of the present application describe a negotiation between an originating and terminating end. By way of example, claim 1 calls for "choosing a compatible personal communication mode from the first plurality of personal communication modes [at an originating end] and the second plurality of personal communication modes" at a terminating end. The remaining independent claims call for a similar negotiation, as independent claims 7 and 13 each call for identifying a compatible mode of the "plurality of communication modes associated with the terminating end."

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The Office Action cites Tangorra as disclosing "a method for establishing a personal communication between an originating end (Figure 1, mobile station 26) and a terminating end (Figure 1, base station 30, 32)" (Office Action, p. 2, sec. 3). Tangorra describes a "method of toggling service option assignments between base and mobile stations" (Tangorra, col. 3, ll. 51-52). The Office Action, therefore, identifies the base station as a terminating end.

But it is clear that teachings of Tangorra regarding the base station do not suggest the "terminating end" of the present claims. A "terminating end" is made up of, *inter alia*, one or more *communication devices*. This meaning is clearly set forth in the Specification, and is consistent with its usage in the art (*See* Original Application, p. 3, ll. 8-9; Figs. 1-3, Reference Numeral 124). Moreover, the Specification provides a number of examples of such communication devices, including touch tone telephones, smart telephones, wireless phones, pagers, personal computers, laptop computers, personal digital assistants, and facsimile machines (*Id.*, Fig. 4). The claims thus call for a determination of compatible communication modes between an originating device and a *device on the terminating end*.

Tangorra, on the other hand, describes base stations which include a number of service options (BSPSOs) with different preference levels specified "by the base station operator for reasons of efficiency" (Tangorra, col. 3, ll. 44-47). The "toggling" of Tangorra is between a mobile station and a base station (*Id.*, Fig. 1, Reference Numerals 26, 30). A *base station* "steps through its list of [service options] and selects the next most preferred [service option]" (*Id.*, col. 5, ll. 55-57). Therefore the toggling is between an originating end and an intermediate node (i.e., the base station). Referring to Fig. 1 of Tangorra, the base station *is not the terminating end* of the communication, *but is an intermediate link* between the mobile station, 26, and the PSTN, 12 (*Id.*, Fig. 1). The terminating end in Tangorra is not shown, but it may be assumed to be connected to the PSTN.

Tangorra, therefore, does not teach or suggest the negotiation of a personal communication mode between an originating *and* terminating end. The Applicant respectfully submits that the specified limitations in independent claims 1, 7 and 13 are not taught or suggested in Tangorra, and that these claims are allowable for at least the foregoing reasons.

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Claims 2, 3, 5, 6, 8, 9, 11, 12, 14-18 and 20 depend from these independent claims, and are believed allowable for at least the same reasons as given above.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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